Appl. No. 09/822,156
Final Office Action mailed June 22, 2004
Response to Final Office Action mailed August 13, 2004

PATENT

REMARKS

This paper is in response to the final Office Action of June 22, 2004. The due date for response extends to September 22, 2004. Applicant respectfully requests reconsideration of the outstanding rejection in view of the following Remarks.

Amendments

The Abstract is amended to correct a grammatical error noted in the last sentence thereof, and to reduce unnecessary verbiage and redundant language in the first two sentences. This amendment presents no new issues requiring further consideration or search. Entry thereof is therefore respectfully requested.

Claims 9-16 are canceled without prejudice. Otherwise, amendments are made to the claims 1 and 17 as expressly directed by the Examiner and therefore introduce no new issues requiring further consideration or search. Since no new issues are presented, immediate entry of these Amendments is requested in accordance with 37 C.F.R. §1.116(b).

Rejections Under 35 U.S.C. §112

Claims 1-24 stand rejected under 35 U.S.C. §112, second paragraph for being indefinite. Applicant respectfully traverses because either the rejected claim is canceled or the rejection is improper.

Claims 9-16 have been canceled thereby obviating any rejection thereagainst. With regard to the remaining claims, the final Office Action cites three grounds for rejection. First, that "said capsule" as it appears in claims 1, 9, and 17 should read "said compute capsule". Second, that "said processes" as it appears in claims 1, 9, and 17 should read, "said interconnected processes". Applicant disagrees that the added adjective in each case is necessary since the words "capsule" and "processes" are each used only in reference to one element of the invention and is therefore not ambiguous or indefinite by itself. However, Applicants are not opposed to making the changes specifically proposed by the Examiner. All instances of "said processes" and "said capsule" have been amended according to the Examiner's instruction. No new issues are presented by this amendment and entry thereof is respectfully requested.

The third ground for rejection lies in the confusion on the part of the Examiner as to the meaning of "determining a state of said capsule" set forth in claim 1. The state of the capsule is defined in the specification, page 15, lines 3-4, and is further explained from that

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point to page 16, line 13. On the Application Publication (US 2002/0174265) this description appears from paragraphs 43-50. Thus, the step of "determining a state of said capsule" involves acquiring the necessary information defined by the capsule state as described in the specification.

Applicants respectfully submit that the phrase "determining a state of said capsule" is sufficiently definite to overcome an indefiniteness rejection when interpreted in accordance with the definition clearly provided in the specification along with the plain meaning one of ordinary skill in the art would attribute to it. Withdrawal of the outstanding rejection is therefore respectfully requested.

Rejection under 35 U.S.C. §101

Claims 1-16 stand rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. Applicant respectfully disagrees. Claims 9-16 are canceled without prejudice by the present amendment thereby obviating any rejection held against them.

The outstanding Office Action states that "Claims 1-8 are directed towards 'a method' whereas they should be directed towards 'a method in a computer system'.

The presently claimed method does not fall into the exception for computer-related processes as it is well within one of the safe harbor provisions. In this case, the process of encapsulating a plurality of processes and system environment is a practical application because it allows for the environment to be halted, stored, and restarted. See MPEP 2106(IV)(B)(2)(b)(ii). Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §101 against claims 1-8.

Rejection under 35 U.S.C. §103(a)

Claims 1-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schrimpf ("Migration of Processes, Files, and Virtual Devices in the MDX Operating System", pages 70-81, 1995), hereinafter referred to as "Schrimpf". Applicant respectfully traverses because not all claim limitations are taught or suggested by the prior art and because the prior art lacks motivation to make the modifications proposed in the outstanding Office Action.

Claims 9-16 have been canceled without prejudice thereby obviating any rejections pending thereagainst. Withdrawal of the rejection as it pertains to these claims is respectfully requested.

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The outstanding Office Action stipulates that Schrimpf does not disclose encapsulating a plurality of interconnected processes into a compute capsule for representing said active computing environment, encapsulating a system environment interconnected with said processes into said capsule, nor obtaining said processes in said capsule. However, the Examiner argues that "it would have been obvious . . . to store data regarding the state of the processes and environment of Schrimpf in a capsule in order to simplify the access to and management of this data." Applicant respectfully disagrees.

For a *prima facie* case of obviousness, the prior art must provide some suggestion or motivation to modify the references. Even assuming *arguendo* that the modification would provide some advantage to Schrimpf as the Examiner suggests (in the present case, simplifying the access to and management of data) this is insufficient rationale to render a *prima facie* obviousness rejection under section 103. If it were otherwise, then any invention that provides some advantage over prior art would not be patentable.

Rather, the specific motivation to make the modification must be present in the prior art and cannot be simply that some advantage results from the invention, even if the advantage would have been recognized at the time the invention was made. Hindsight analysis is improper because it confuses prior art suggestion or motivation to modify or combine references with the idea that some advantage provided by an invention would have been appreciated at the time the invention was made. That an advantage would have been appreciated does not translate to actual motivation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the *prior art* also suggests the desirability of the combination. See MPEP 2143.01. Applicants respectfully submit that the outstanding obviousness rejection relies on improper hindsight analysis and should be withdrawn.

Notwithstanding the above, Applicants respectfully submit that the encapsulating steps set forth in claim 1 would not be beneficial to Schrimpf, and in fact that Schrimpf implicitly teaches away from the encapsulating step. First, creating a compute capsule representing an active computing environment would not necessarily aid in load balancing if that environment represented a great deal of load on system resources, since the entirety of that load would simply be placed onto another resource and the load would still be unbalanced. Secondly, the encapsulation steps would add to the number of steps and therefore the time it would take to migrate the processes as described by Schrimpf, which is explicitly expressed as undesirable in Schrimpf, page 72, lines 4-5 of the first full paragraph: "Migration . . . should not interrupt

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execution for long." Not only did Schrimpf and those having general knowledge in the field of art lack motivation to modify Schrimpf as suggested in the outstanding action, Schrimpf implicitly teaches away from the proposed modification as it would have increased the time necessary to make the migration and it would not have been helpful in load balancing.

In view of the foregoing Amendments and Remarks, Applicants respectfully submit that the present application is in condition for allowance. A Notice of Allowance is therefore respectfully requested.

If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900 x6933. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP585). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
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